



D-1112 R4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
Enright, et al.)	
)	
Application No.: 09/991,748)	Art Unit 3692
)	
Confirmation No.: 7030)	
)	
Filed: November 23, 2001)	Patent Examiner
)	Frantzy Poinvil
)	
Title: Automated Banking Machine)	
System and Method)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPEAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby submit their Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Appeal Brief is in response to the Office Action dated October 19, 2006, which was made final.

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

This Application claims priority to Provisional applications 60/103,731 and 60/253,221. At least two other appealed applications (e.g., 09/414,290 and 10/603,266) claim priority to an aforementioned Provisional application. It is believed that no other appealed application pertains to the claimed subject matter. However, it is respectfully requested that the Board of Appeals and Interferences (“Board”) make its own determination regarding the pertinence of any other application.

Appellants, Appellants’ legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-39 are pending in the Application.

Claims rejected: 1-39

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-39, inclusive. These rejections were in the Office Action (“Action”) dated October 19, 2006, which was made final.

(iv)

STATUS OF AMENDMENTS

The rejections in the Action dated October 19, 2006 were made final. No claim amendments were requested to be admitted after the final rejection. However, a "Request for Reconsideration" was filed on March 27, 2007 in response to the "Notice of Panel Decision from Pre-Appeal Brief Review" dated March 7, 2007.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

For reasons of brevity, claim language may be referred to herein (and in Appellants' arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any shortened/generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to a method. The method includes providing in an automated banking machine (e.g., an ATM 12, 146, 180, 228, 332; at respective specification pages 22, 53, 58, 61, and 88), a document (e.g., a check; page 44, line 7; page 61, lines 3-4) requiring a signature to achieve a legal effect (e.g., page 66, lines 10-12; page 67, lines 7-11, 15-18, and 22).

The method also includes receiving at least one input from a user of the machine (e.g., ATM 12; Figure 1) indicative of user agreement that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user (e.g., page 66, lines 13-15; page 67, lines 5-7; page 68, lines 15-17 and 21-22; page 70, line 20 to page 71, line 3; and page 125, lines 6-8).

The method further includes acquiring the (image) data of the user (e.g., via a camera 24, 26 in Figure 1; page 23, lines 5-9; page 68, line 10 to page 69, line 2) through operation of the machine (e.g., ATM 12). Additionally note pages 66-69.

With respect to independent claim 17

Another exemplary form of the invention is directed to a method. Location of support in the disclosure for similar claim language has been previously provided.

The method includes providing in an automated banking machine (e.g., ATM 12), a document (e.g., a check) to which a person's signature provides legal effect; receiving agreement input from a machine user that an electronic signature of the user for purposes of providing legal effect to the document shall include data corresponding to at least one user input to the machine (e.g., pages 66-69; page 66, lines 18-22; page 69, lines 6-10); and acquiring the data corresponding to at least one user input through operation of the machine (e.g., page 69, lines 1-3).

With respect to independent claim 26

Another exemplary form of the invention is directed to an apparatus. Location of support in the disclosure for similar claim language has been previously provided.

The apparatus comprises an automated banking machine (e.g., ATM 12; Figure 1). The machine includes a document processing device (e.g., check imager 230; Figure 13; page 68, lines 10-13) for a document (e.g., a check) for which a signature has legal effect (e.g., pages 66-69).

The machine further includes an output device (e.g., a display; Figure 1; page 68, lines 15-16) and a controller (e.g., 38; Figure 2; page 24, lines 16-18) including software (e.g., page 68, lines 6-9). The controller can cause the output device (e.g., display) to ask (e.g., page 68, lines 6-9 and 15-17) a machine user if the user agrees that image data corresponding to at least one imaged portion of the user shall constitute an electronic signature of the user for purposes of signing the document (e.g., pages 66-69).

The machine also includes an input device (e.g., a keypad 16; Figure 1; page 22). The input device is operative to receive user input indicating agreement by the user that the image data shall constitute an electronic signature of the user for purposes of signing the document (e.g., a check; pages 66-69).

The machine additionally includes an image acquisition device (e.g., camera 24; Figure 1) operative to acquire the image data (e.g., page 68, line 21 to page 69, line 2).

The controller (e.g., 38) is in operative connection with the document processing device (e.g., check imager 230), the at least one output device (e.g., display), the at least one input device (e.g., a keypad 16), and the at least one image acquisition device (e.g., camera 24). The controller (e.g., 38) can cause the image data to be correlated with the document (e.g., check) as the electronic signature of the user for the document (e.g., pages 66-69).

With respect to independent claim 36

Another exemplary form of the invention is directed to a method. Location of support in the disclosure for similar claim language has been previously provided.

The method includes operating an automated banking machine (e.g., ATM 12) to receive from a user of the machine a financial check needing signature from the user in order to be processed. The machine includes a cash dispenser (e.g., 20; Figure 2) operative to dispense cash from the machine (e.g., ATM).

The method also includes operating the machine (e.g., ATM) to receive agreement from the user that at least one image of the user constitutes a legally binding electronic signature of the user for purposes of processing the check (e.g., pages 66-69).

The method additionally includes operating the machine (e.g., ATM) to capture (e.g., camera 24) a user image.

The method further includes operating the machine (e.g., ATM) to correlate the check with the user image as the electronic signature of the user for purposes of processing the check (e.g., page 42, lines 3-7; page 61, lines 9-14; page 63, lines 5-7; page 69, lines 6-10).

With respect to independent claim 37

Another exemplary form of the invention is directed to a method. Location of support in the disclosure for similar claim language has been previously provided.

The method includes operating an automated banking machine (e.g., ATM 12) to obtain user identity data (e.g., a user image) from a user of the machine (e.g., Figure 9; page 49, lines 1-11; page 72, lines 16-17), where the machine includes a cash dispenser (e.g., 20; Figure 2).

The method also includes operating the machine (e.g., ATM) to produce an output (e.g., display) requesting the user to authorize having user identity data (e.g., a user image) serve as an electronic signature of the user (e.g., page 68, lines 6-9 and 15-17).

The method further includes operating the machine (e.g., ATM) to receive from the user via user input to the machine, authorization to have user identity data (e.g., user image) serve as an electronic signature of the user.

The method additionally includes operating the machine (e.g., ATM) to link (e.g., check/user image correlation; page 42, lines 3-7; page 61, lines 9-14; page 63, lines 5-7; page 69, lines 6-10) the obtained user identity data (e.g., user image) to a document (e.g., check) to which a signature of the user has legal significance, where the user identity data is linked so as to serve as the electronic signature of the user for the document.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-39 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Stinson, et al. (US 6,149,056) (hereafter "Stinson").

(vii)

ARGUMENT

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Stinson does not anticipate the claims

Claims 1-39 were rejected under 35 U.S.C. § 102(e) as being anticipated by Stinson.

Appellants respectfully submit that the Office has not established that Stinson anticipates the claims. Nor does Stinson anticipate the claims.

Appellants respectfully disagree with the features attributed by the Office to the Stinson reference. Stinson does not explicitly or inherently anticipate the claims.

The Stinson reference

Stinson is directed to a paycheck cashing process which allows for multiple levels (if necessary) of data review before determining whether to approve or reject the cashing of a paycheck. These different levels include an automated check-cashing unit (100), an automated server (500) of a centralized services center ("CSC") (400), a CSC human operator, and an operator supervisor.

Stinson discloses an ATM (350) that has its own processor (355) (e.g., Figure 3A). The ATM (350) can be connected through a network (Figure 6A at step 650; col. 7, lines 66-67) to a processor (300) of the check-cashing unit (100) (e.g., Figure 3A). A plurality of the check-cashing units (100) can communicate with the CSC (400) (e.g., Figure 4).

The ATM (350) operates according to a procedure (600). The processor (300) operates according to a separate procedure (700). The CSC operates according to yet another procedure (800).

The ATM (350) merely obtains transaction information and then sends it to the networked processor (300) (i.e., step 650). The information sent includes the customer's identification number, images of the front and back of a check, MICR information, whether the check passed a validation step, a check amount read by OCR, a check amount entered by the customer, and any difference between the two amounts.

The processor (300) receives an image of the customer's face directly from a camera (125) (col. 5, lines 58-62). The processor uses the facial image and the information received from the ATM (350) in trying to identify the customer (step 710). Identification software is used by the processor to compare the facial image from the camera (125) with an image already stored in conjunction with the customer's identification number in the unit's storage device (320).

The processor (300) can automatically approve the cashing of a check if both the facial image matches the stored image (step 715) and a set of business rules are satisfied (step 720). The processor can record the approved transaction on the unit's storage device (320). However, if either the business rules are not met or the customer can't be identified by the processor (300), then the CSC (400) is needed (step 745) for check review in order to authorize a check cashing. The processor (300) can send the transaction to the CSC (400) using an ISDN line (step 755).

The CSC (400) includes a server (500) which receives and processes calls from the units (100). The server 500 maintains a much larger database of customer information than any of the units (100). For this reason, the server (500) may be able to identify a customer and automatically verify and authorize a transaction the unit (100) was unable to authorize.

The server (500) can also verify a transaction against a set of business rules (step 841). If the transaction does not satisfy the business rules (step 843), then the server (500) can send the

transaction to a workstation (510) of a CSC human operator (step 847), who can accept or reject the transaction. While the CSC operator reviews the transaction for decision, the server (500) can update its database with transactions information obtained from the processor (300) regarding previous transactions that the processor had independently processed since its last call to the server (step 865).

The CSC operator can also send or pass the transaction to an operator supervisor. The supervisor can carry out functions similar to those of the operator in making the approve/reject decision.

For tracking purposes, a check record associated with each check handled by the CSC includes a status code, a check disposition code, and an operator code. A status code of "A" indicates that the check is waiting to be handled by an operator/supervisor, whereas a status code of "C" indicates that the check has been processed by an operator/supervisor.

Check disposition code 11 (or 12) indicates that the check was accepted (or rejected) by the unit (100). Check disposition code 21 (or 22) indicates that the check was accepted (or rejected) by the CSC server (500). Check disposition code 31 (or 32) indicates that the check was accepted (or rejected) by a CSC operator. Check disposition code 41 (or 42) indicates that the check was accepted (or rejected) by a CSC supervisor.

The operator code is blank until the active check has been assigned to a specific operator, and thereafter identifies that operator. For example, if a qualified operator (e.g., an operator who speaks the appropriate language) is available, then that operator's number is placed into the operator code for the check and information about the check is passed to that operator.

Stinson does not anticipate the claims

- Stinson does not teach, mention, or need "electronic signature".

Conversely, each of the independent claims 1, 17, 26, 36, and 37 include "electronic signature". It follows that Stinson is non analogous art with regard to electronic signature.

Additionally, Stinson is not concerned with an electronic signature of an automated banking machine user. Thus, Stinson cannot anticipate the claims.

- In Stinson, the customer signs the check *before* it is even inserted into the machine (e.g., col. 7, lines 46-58).

Even the Office (e.g., at Action page 3, last paragraph) admits that Stinson teaches that the customer is required to endorse (sign) a check by writing their signature on the check. One having ordinary skill in the art would recognize that Stinson's requirement for a handwritten signature *teaches away* from Stinson using (or even needing) an electronic signature. Nor has the Office explained what purpose an electronic signature would serve in Stinson when a handwritten signature is what is required and relied upon by Stinson, as admitted by the Office. Again, Stinson cannot anticipate the claims.

- Stinson does not receive an agreement input (regarding electronic signature) from a user of the machine.

The Action (at page 3, last paragraph to page 4, line 1) alleges that "the machine or ATM system of Stinson et al asked the user" to agree that an "imaged portion of the user shall constitute an electronic signature of the user for purposes of signing the document" and "it is then inherent that the user has/had agreed" (at page 3, last paragraph). The Appellants respectfully disagree.

- First, the Action is conveniently silent as to where any teaching that a machine "asked the user" for authorization can be found in the relied upon Stinson reference.

Conversely, Stinson provides no support for the Office's allegation. Nor does Stinson teach the alleged "asking" feature. Again, Stinson does not anticipate the claims.

- Second, as previously mentioned, if Stinson uses a customer's handwritten signature (as admitted by the Office), then why would Stinson need a user's "agreement" to use electronic signature "for purposes of signing the document" (Action at page 4, line 1), as alleged by the Office? Stinson wouldn't.

Conversely, Stinson's requirement for a handwritten signature *teaches away* from any need for electronic signature or any need for an electronic signature agreement from a user. Again, Stinson does not anticipate the claims.

- Third, even if Stinson somehow taught (which Stinson doesn't) the Office's allegation (at page 3, last paragraph) that "the user has/had agreed to" authorization, the agreement would not have been received via input *from a user of the machine* (e.g., claim 1 language).

Even the Action's past tense usage of "has/had agreed" indicates any customer agreement (if somehow even possible, which it isn't) in Stinson would have occurred before the customer even used the machine. Again, Stinson does not anticipate the claims.

- Fourth, the Office's allegation (at page 3, last paragraph) that "it is then *inherent* that the user has/had agreed" is without any supporting basis whatsoever.

To establish inherency the Office must prove that the features alleged to be inherent are mandatory or "necessarily present" in Stinson. *In re Robertson*, supra. The Office has not proved the alleged inherency. Nor is structure that absolutely requires the carrying out of the recited methods (e.g., claims 1, 17, 36, and 37) mandatory or "necessarily present" in Stinson. Nor is there any prior art evidence of record that Stinson's structure, in its normal and usual operation, would be required to perform the recited methods. Again, Stinson does not anticipate the claims.

There are even further reasons why Stinson does not anticipate the claims. For example, Stinson also does not teach the relationships among an automated banking machine, a document, a user of the machine, user agreement input, electronic signature of the user, and/or a user image (e.g., claim 1).

The Office has failed to show on the record any valid basis for the allegation of anticipation. Appellants are not required to prove patentability. Rather, the burden is on the Office to establish a *prima facie* case of anticipation under the law. Appellants respectfully submit that the Office has not met its legally required burden. Conversely, Appellants have provided numerous reasons that constitute *prima facie* evidence against Stinson anticipating the claims. Thus, Appellants respectfully submit that the claim rejections are not legally valid and should be reversed.

Additional arguments (regarding specific claims) against the allegations of anticipation follow.

Claim 1

Claim 1 recites "receiving at least one input from a user of the machine indicative that the user agrees that the user's *electronic signature* shall include data corresponding to at least one image of at least a portion of the user". Again, Stinson does not teach, mention, or need "electronic signature". Thus, Stinson cannot anticipate claim 1.

Stinson is even further removed from teaching an electronic signature that corresponds to an "image"; an image of "*a user*"; an image of "*a user of the machine*"; and an image of "*a user of*" "*an automated banking machine*". Where does Stinson correspond an electronic signature to an image of a banking machine user? Stinson doesn't. Stinson cannot anticipate claim 1.

Furthermore, where does Stinson receive an agreement input from a machine user, where the input indicates an agreement by the user for his/her electronic signature to include user image data? Stinson doesn't. Stinson teaches neither an electronic signature/user image relationship nor a user agreement for that relationship. Again, Stinson cannot anticipate claim 1.

Also, claim 1 (step c) recites that it is through operation of an automated banking machine (in which the document is provided) that data corresponding to an image of the user is acquired. Conversely, Stinson teaches that his ATM (350) is separate from both the check-cashing unit (100) and the CSC (400). The ATM (350) even has its own processor (355) (e.g., Figure 3A) which is distinguished from the unit's processor (300). The remote ATM (350) is connected to the unit (100) via a network (Figure 6A at step 650; col. 7, lines 66-67).

Where does Stinson teach that the ATM (350) operates the camera (125) to capture the facial image? Stinson doesn't. Rather, Stinson teaches that the processor (300) receives an image of the customer's face directly from the camera (125) (col. 5, lines 58-62). In other words,

in Stinson the camera (125) is not part of the ATM (350). Also note Figures 3A and 3B which show that a camera (125) is not part of the ATM (350).

Where does Stinson teach that the ATM (350) operates the camera (125) to capture the facial image, and then the ATM (350) sends the captured facial image to the unit's processor (300)? Stinson doesn't. Stinson (at col. 8, lines 1-6) lists the information that the ATM (350) sends to the processor (300). A captured *user image* is not part of the sent information. At best, the ATM (350) displays a message that informs a customer to remove items that would obscure the customer's face, but it is the identification software in the processor (300) that controls and operates the camera (125) to receive user images therefrom. It follows that Stinson also does not teach recited step (c).

Appellants have shown that Stinson does not explicitly or inherently teaching the recited features and relationships of claim 1. The rejection is based on assertions which Stinson cannot support. The Office has not met its burden of establishing anticipation. Nor can it, because Stinson does not teach the features, relationships, and steps recited in claim 1.

Claim 2

Stinson further does not teach applying indicia corresponding to a user image to a document. Where does Stinson apply to a check (the alleged document, as best understood), indicia corresponding to a user image? Stinson doesn't. The section of Stinson relied upon by the Office does not teach the recited features. Stinson does not anticipate claim 2.

Claim 3

Claim 3 depends from claim 2. Nor does Stinson apply to a check (the alleged document), a visual representation of at least a portion of the user. Stinson teaches away from

the recited method. At best, Stinson uses a camera image (the alleged user image data, at best understood) to confirm the identity of a customer. The camera image is not applied as indicia to a check (the alleged document). Stinson does not anticipate claim 3.

Claim 4

Claim 4 depends from claim 3. Nor does Stinson apply to a check (the alleged document), a visual representation of the user's face. Where does Stinson apply a visual representation of a customer's face to a check? Stinson does not anticipate claim 4.

Claim 5

Claim 5 depends from claim 2. Stinson further does not teach that the indicia includes machine readable indicia. Stinson does not anticipate claim 5.

Claim 6

For reasons previously discussed, Stinson is not concerned with an electronic signature that corresponds to an image of the user's face. Stinson does not anticipate claim 6.

Claim 7

For reasons previously discussed, Stinson is not concerned with an electronic signature that corresponds to an image of the user's fingerprint. Stinson does not anticipate claim 7.

Claim 8

For reasons previously discussed, Stinson is not concerned with an electronic signature that corresponds to an image of the user's iris. Where does Stinson even mention "iris"? Stinson does not anticipate claim 8.

Claim 9

As previously discussed, Stinson does not teach recited steps (a)-(c) of claim 1. It follows that Stinson cannot teach the producing step of claim 9.

Claim 10

Claim 10 depends from claim 9. Stinson further does not teach storing in a data store, an electronic representation of the document in correlated relation with user image data.

Stinson teaches away from the recited storing. At best, Stinson uses a camera image (of a customer's face) to confirm the identity of a current customer. That is, Stinson compares an image of a customer's face produced by the camera (125) to a facial image already stored in conjunction with the customer's identification number. However, there is no evidence of record that Stinson's camera image (the alleged user image data, at best understood) is ever stored in correlated relation with an electronic representation of a check (the alleged document). Nor does Stinson need to store an image of a customer's face in correlated relation with a check image. Stinson is silent as to what transaction data is stored and how it is stored. Stinson does not anticipate claim 10.

Claim 11

Stinson further does not teach storing in a data store, user input data in correlated relation with user image data. Stinson does not anticipate claim 11.

Claim 12

Claim 12 depends from claim 2. As previously discussed, Stinson does not teach recited steps (a)-(c) of claim 1. It follows that Stinson cannot teach the additional step of delivering the document from the machine to the user. Stinson does not anticipate claim 12.

Claim 13

Claim 13 depends from claim 2. As previously discussed, Stinson does not teach recited steps (a)-(c). It follows that Stinson cannot teach the additional step of storing the document in the machine. Furthermore, where does Stinson specifically teach storing a check (the alleged document) in an automated banking machine? Stinson does not anticipate claim 13.

Claim 14

As previously discussed, Stinson does not teach recited steps (a)-(c). It follows that Stinson cannot teach that in step (a) the document comprises a negotiable instrument delivered by the user to the machine. Stinson does not anticipate claim 14.

Claim 15

Claim 15 depends from claim 14. Stinson further does not teach that a user provides an input to an automated banking machine, where the user input indicates that user image data shall constitute an *endorsement* of the negotiable instrument. Where does Stinson teach providing/receiving a user agreement input with regard to endorsing a negotiable instrument? Again, the section of Stinson relied upon by the Office does not teach the recited features. Stinson does not anticipate claim 15.

Claim 16

Claim 16 depends from claim 15. Stinson further does not teach applying indicia corresponding to a user image to the document responsive to receiving user agreement input for the user image data to constitute an endorsement of the document. Stinson does not anticipate claim 16.

Claim 17

For reasons of brevity, Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference.

Again, Stinson does not teach "electronic signature". Stinson is non analogous art with regard to electronic signature.

Stinson does not teach receiving from a user of an automated banking machine, input that indicates that the user agrees for his/her electronic signature (for purposes of providing legal effect to the document) to include data corresponding to his/her input to the machine. Where does Stinson teach that a *user of the machine* provides agreement input regarding the legal composition of electronic signature data? Stinson teaches neither an electronic signature/user input relationship nor a user agreement for that relationship.

Stinson does not teach the relationships among an automated banking machine, document, user of the machine, user agreement input, electronic signature of the user, and/or providing legal effect to the document. Stinson cannot anticipate claim 17.

Claim 18

Claim 18 depends from claim 17. Stinson further does not teach receiving user input that indicates user agreement that an electronic signature shall include data corresponding to a machine-acquired user image, and acquiring the data through operation of the machine. The section of Stinson relied upon by the Office does not teach the recited features. Stinson does not anticipate claim 18.

Claim 19

Claim 19 depends from claim 18. As previously discussed, Stinson does not teach recited steps (a)-(c). It follows that Stinson cannot teach a document that comprises a financial check in the manner recited. For reasons already discussed, Stinson's check cannot constitute the document. Nor can Stinson anticipate claim 19.

Claim 20

Claim 20 depends from claim 19. Stinson further does not teach the additional step of applying to a check, indicia corresponding to a machine-acquired user image. Where does Stinson apply a user image to a check? Stinson does not anticipate claim 20.

Claim 21

Stinson further does not teach acquiring user image data through operation of the machine, and storing in correlated relation both data corresponding to the user agreement input and the user image data. Stinson does not anticipate claim 21.

Claim 22

Stinson further does not teach operating an automated banking machine to obtain image data of both a user and a document in the manner recited. Stinson does not anticipate claim 22.

Claim 23

Claim 23 depends from claim 22. Stinson further does not teach operating an automated banking machine to obtain user image data and an electronic image of a document, and store in correlated relation the electronic image of the document and the user image data. Where does Stinson teach the recited correlated storage? Stinson does not anticipate claim 23.

Claim 24

Claim 24 depends from claim 18. Stinson further does not teach acquiring user image data through operation of a camera in the manner recited. Stinson does not anticipate claim 24.

Claim 25

Claim 25 depends from claim 18. For reasons already discussed, Stinson further does not teach acquiring user image data through operation of a biometric reading device in the manner recited. Stinson does not anticipate claim 25.

Claim 26

For reasons of brevity, Appellants' remarks in support of the patentability of the previous independent claims are incorporated herein by reference.

Stinson does not teach the recited automated banking machine. Where does Stinson teach an automated banking machine (including software) with the ability to ask a user of the machine if he/she agrees to have their user image data constitute his/her electronic signature for purposes of signing a document? Stinson doesn't.

Nor does Stinson teach a machine that is further able to receive user input indicative of the user agreement; acquire the user image data; and cause the acquired user image data to be correlated (as the user's electronic signature for the document) with the document.

Also, Stinson teaches away from correlating machine-acquired user image data to a document, especially with the user image data being the user's electronic signature for the document. There is no evidence of record that Stinson's camera image (the alleged user image data, as best understood) is ever stored in correlated relation with a check (the alleged document). Regardless, there is no evidence of record that Stinson stores a machine-acquired user image as

electronic signature for a document. At best, Stinson uses a camera image to confirm the identity of a customer. That is, Stinson compares an image of a customer's face produced by the camera (125) to a facial image already stored in conjunction with the customer's identification number. However, there is no evidence of record that Stinson's camera image (the alleged user image data, at best understood) is ever correlated as an electronic signature for a document. Stinson is also silent as to what transaction data is stored and how it is stored. Stinson does not anticipate claim 26.

Also, claim 26 recites that it is through an image acquisition device of an automated banking machine (in which the document is processed) that user image data is acquired. As previously discussed (e.g., claim 1 remarks), Stinson distinguishes the ATM (350) from the unit's processor (300). Stinson also teaches that the processor (300) receives an image of the customer's face directly from the camera (125) (col. 5, lines 58-62). In other words, in Stinson the camera (125) is not part of the ATM (350). It follows that Stinson does not teach an image acquisition device of an automated banking machine in the manner recited. Again, Stinson does not anticipate claim 26.

Claim 27

Claim 27 depends from claim 26. Stinson further does not teach an automated banking machine with the ability to acquire user image data, receive user agreement input, and cause data corresponding to the user agreement input to be stored in correlated relation with the user image data. The section of Stinson relied upon by the Office does not teach the recited features. Stinson does not anticipate claim 27.

Claim 28

Claim 28 depends from claim 26. Stinson further does not teach an automated banking machine that includes a marking device that is operative to apply to a document, indicia corresponding to machine-acquired image data. The Action is silent as to where the recited "marking device" can be found in Stinson. Nor can Stinson anticipate claim 28.

Claim 29

Claim 29 depends from claim 26. Stinson further does not teach an automated banking machine that can cause document visual representation data to be stored in correlated relation with user input data. Stinson does not anticipate claim 29.

Claim 30

Claim 30 depends from claim 29. Stinson further does not teach an automated banking machine that can cause user image data to be stored in correlated relation with at least one of user input data and document visual representation data. Stinson does not anticipate claim 30.

Claim 31

Claim 31 depends from claim 28. Stinson further does not teach an automated banking machine that includes a marking device that is operative to apply to a check (the alleged document), indicia that comprises a visual representation of a user. Where does Stinson apply a user image to a check (as apparently alleged by the Office)? Stinson does not anticipate claim 31.

Claim 32

Claim 32 depends from claim 31. Furthermore, where does Stinson apply a user's facial image to a check (as apparently alleged by the Office)? Stinson does not anticipate claim 32.

Claim 33

Claim 33 depends from claim 26. For reasons already discussed, Stinson also does not teach an image acquisition device comprising a biometric reading device in the manner recited. Stinson does not anticipate claim 33.

Claim 34

Claim 34 depends from claim 28. Stinson further does not teach an automated banking machine that includes a marking device that is operative to apply machine readable indicia to a check (the alleged document). Where does Stinson apply machine readable indicia to a check (as apparently alleged by the Office)? Stinson does not anticipate claim 34.

Claim 35

Claim 35 depends from claim 1. Stinson further does not teach operating an automated banking machine to ask the user if he/she agrees that his/her electronic signature shall include machine-acquired user image data. Stinson does not anticipate claim 35.

Claim 36

For reasons of brevity, Appellants' remarks in support of the patentability of the previous independent claims are incorporated herein by reference.

Where does Stinson have an ability to obtain user permission to use an electronic signature in processing a received check that is *needing* a user signature? Instead, Stinson simply returns to the user any check needing a user signature (col. 7, lines 53-57).

Where does Stinson teach operating a check-receiving automated banking machine to receive an agreement from the machine user for an image of the user to constitute the user's legally binding electronic signature for purposes of processing a check received by the machine?

Nor does Stinson teach operating the machine to correlate the check with a user image as the electronic signature of the user for purposes of processing the check. Where does Stinson operate an automated banking machine to correlate a user check with a user's image (as the user's electronic signature), especially for processing the check? For reasons previously discussed (e.g., claim 26), Stinson teaches away from correlating a check with a machine-captured user image as an electronic signature. There is also no evidence of record that Stinson's camera image (the alleged user image, as best understood) is ever correlated (with a check) as a user's electronic signature. Stinson does not anticipate claim 36.

Also, where does Stinson teach operating an automated banking machine (in which the document is received) to capture a user image? Stinson's ATM (350) does not operate the camera (125) to capture a user image. Rather, (as previously discussed with regard to claim 1, step c), Stinson teaches that it is the processor (300), not the ATM (350), that receives an image of the customer's face from the camera (125) (col. 5, lines 58-62). In other words, in Stinson the camera (125) is not part of the (document is receiving) ATM (350). It follows that Stinson also does not teach recited step (c). Again, Stinson does not anticipate claim 36.

Claim 37

For reasons of brevity, Appellants' remarks in support of the patentability of the previous independent claims are incorporated herein by reference.

Stinson does not teach operating a cash-dispensing automated banking machine to *output* to the machine user, a request for authorization to have user identity data serve as the user's electronic signature.

Nor does Stinson teach operating the machine to *receive* authorization input from the user to have user identity data serve as the user's electronic signature.

Nor does Stinson teach operating the machine to link obtained user identity data to a document to which a user signature has legal significance, where the user identity data is linked in a manner that allows it to serve as the user's electronic signature for that document. For reasons previously discussed (e.g., claims 26 and 36), Stinson teaches away from linking a check (the alleged document) to obtained user identity data as electronic signature for the check. Stinson's camera image (the alleged user identity data, as best understood) is not linked as being an electronic signature to anything, let alone a check. Stinson doesn't even discuss "electronic signature".

Furthermore, claim 37 recites that it is through operation of a cash-dispensing automated banking machine that the linking occurs. Stinson teaches that the ATM (350) is separate from both the check-cashing unit (100) and the CSC (400). The ATM (350) even has its own processor (355) (e.g., Figure 3A) which is distinguished from the unit's processor (300). The remote ATM (350) is connected to the unit (100) via a network (Figure 6A at step 650; col. 7, lines 66-67). Where does Stinson teach that operation of the ATM (350) causes the recited linking? Stinson doesn't.

The Office has not met its burden of establishing anticipation. Nor can Stinson anticipate claim 37.

Claim 38

Claim 38 depends from claim 37. For reasons previously discussed, Stinson teaches away from operating a cash-dispensing automated banking machine to correlate a check to

obtained user identity data in a manner that enables the user identity data to serve as an electronic signature for the check. Stinson does not anticipate claim 38.

Claim 39

Claim 39 depends from claim 38. For reasons previously discussed, Stinson teaches away from operating a cash-dispensing automated banking machine to produce check image data in the manner recited. Stinson does not anticipate claim 39.

CONCLUSION

Each of Appellants' claims specifically recites features, relationships, and/or steps that are not disclosed in the applied prior art. Stinson does not anticipate the claims. For these reasons it is respectfully submitted that all the claims are allowable.

Respectfully submitted,



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CLAIMS APPENDIX

1. A method comprising:
 - (a) providing in an automated banking machine a document requiring a signature to achieve a legal effect;
 - (b) receiving at least one input from a user of the machine indicative that the user agrees that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user;
 - (c) acquiring the data corresponding to at least one image of the user through operation of the machine.
2. The method according to claim 1 and further comprising:
 - (d) applying indicia corresponding to the at least one image to the document.
3. The method according to claim 2 wherein in step (d) the indicia comprises a visual representation of at least a portion of the user.

4. The method according to claim 3 wherein in step (d) the visual representation comprises a visual representation of the user's face.
5. The method according to claim 2 wherein the indicia comprises machine readable indicia.
6. The method according to claim 1 wherein the at least one image comprises an image of the user's face.
7. The method according to claim 1 wherein the at least one image comprises an image of a fingerprint of the user.
8. The method according to claim 1 wherein the at least one image comprises an image of an iris of the user.
9. The method according to claim 1 and further comprising:

producing an electronic representation of at least one portion of the document with an imaging device in the machine.
10. The method according to claim 9 and further comprising:

storing in at least one data store, the electronic representation of the at least one portion of the document in correlated relation with the data corresponding to the at least one image of the user.

11. The method according to claim 1 and further comprising storing in at least one data store, data corresponding to the at least one input in correlated relation with the data corresponding to the at least one image.
12. The method according to claim 2 and further comprising:

delivering the document from the machine to the user.
13. The method according to claim 2 and further comprising storing the document in the machine.
14. The method according to claim 1 wherein in step (a) the document comprises a negotiable instrument delivered by the user to the machine.
15. The method according to claim 14 wherein in step (b) the user provides at least one input to the machine indicating that the data corresponding to the at least one image shall constitute endorsement of the negotiable instrument.

16. The method according to claim 15 and further comprising applying indicia corresponding to the at least one image to the document responsive to the at least one input received in step (b).

17. A method comprising:

- (a) providing in an automated banking machine, a document to which a person's signature provides legal effect;
- (b) receiving at least one agreement input from a user of the machine indicating agreement from the user that an electronic signature of the user for purposes of providing legal effect to the document shall include data corresponding to at least one user input to the machine;
- (c) acquiring the data corresponding to at least one user input through operation of the machine.

18. The method according to claim 17

wherein (c) includes acquiring data corresponding to at least one image of at least a portion of the user through operation of the machine;

wherein in step (b) the at least one agreement input received indicates agreement that the electronic signature shall include data corresponding to the at least one image acquired by the machine in (c).

19. The method according to claim 18 wherein the document comprises a financial check, wherein (a) includes receiving a check in the machine from the user.

20. The method according to claim 19 and further comprising

(d) applying indicia corresponding to the at least one image to the check.

21. The method according to claim 17

wherein (c) includes acquiring data corresponding to at least one image of at least a portion of the user through operation of the machine;

and further comprising:

(d) storing in at least one data store in correlated relation, data corresponding to the at least one agreement input received in (b) and data corresponding to the at least one image.

22. The method according to claim 17

wherein (c) includes acquiring data corresponding to at least one image of at least a portion of the user through operation of the machine;

and further comprising:

(d) obtaining at least one electronic image of at least a portion of the document through operation of the automated banking machine.

23. The method according to claim 22 and further comprising:

(e) storing in correlated relation in at least one data store, data corresponding to the at least one electronic image of at least a portion of the document and data corresponding to the at least one image of at least a portion of the user.

24. The method according to claim 18 wherein in (c) the at least one image is acquired through operation of a camera.

25. The method according to claim 18 wherein in (c) the at least one image is acquired through operation of a biometric reading device.

26. An automated banking machine comprising:

a document processing device in the machine operative to process a document for which a signature has legal effect,

at least one output device,

at least one controller including software,

wherein the controller is operative to cause the at least one output device to ask a user of the machine if the user agrees that image data corresponding to at least one imaged portion of the user shall constitute an electronic signature of the user for purposes of signing the document,

at least one input device,

wherein the at least one input device is operative to receive from the user at least one user input indicating agreement by the user that the image data shall constitute an electronic signature of the user for purposes of signing the document,

at least one image acquisition device, wherein the at least one image acquisition device is operative to acquire the image data,

wherein the at least one controller is in operative connection with the document processing device, the at least one output device, the at least one input device, and the at least one image acquisition device,

wherein the at least one controller is operative to cause the image data to be correlated with the document as the electronic signature of the user for the document.

27. The machine according to claim 26 and further comprising a data store, wherein the at least one controller is in operative connection with the data store, wherein the controller is operative to cause data corresponding to the at least one user input to be stored in the data store in correlated relation with the image data.
28. The machine according to claim 26 and further comprising a marking device, wherein the marking device is operative to apply to the document indicia corresponding to the image data.
29. The machine according to claim 26 wherein the document processing device comprises an imager operative to produce data corresponding to a visual representation of at least a portion of the document, and wherein the at least one controller is in operative connection with a data store, and wherein the controller is operative to cause the data corresponding

to the visual representation of at least a portion of the document to be stored in correlated relation with data corresponding to the at least one user input.

30. The machine according to claim 29 wherein the controller is further operative to cause the image data to be stored in correlated relation with at least one of the data corresponding to the at least one user input and the data corresponding to the visual representation of at least a portion of the document.
31. The machine according to claim 28 wherein the indicia comprises a visual representation of at least a portion of a user.
32. The machine according to claim 31 wherein the visual representation comprises a visual representation of a user's face.
33. The method according to claim 26 wherein the at least one image acquisition device comprises a biometric reading device.
34. The machine according to claim 28 wherein the indicia comprises machine readable indicia.
35. The method according to claim 1 wherein the machine includes a cash dispenser operative to dispense cash from the machine, and further comprising:

- (d) prior to step (b), operating the machine to produce at least one output asking the user if the user agrees that an electronic signature of the user shall include data corresponding to at least one image of at least a portion of the user.

36. A method comprising:

- (a) operating an automated banking machine to receive from a user of the machine a financial check needing signature from the user in order to be processed, wherein the machine includes a cash dispenser operative to dispense cash from the machine;
- (b) operating the machine to receive agreement from the user that at least one image of the user constitutes a legally binding electronic signature of the user for purposes of processing the check;
- (c) operating the machine to capture at least one user image of at least a portion of the user; and
- (d) subsequent to (c), operating the machine to correlate the check with the at least one user image as the electronic signature of the user for purposes of processing the check.

37. A method comprising:

- (a) operating an automated banking machine to obtain user identity data from a user of the machine, wherein the machine includes a cash dispenser operative to dispense cash from the machine;
- (b) operating the machine to produce at least one output requesting the user to authorize having user identity data serve as an electronic signature of the user;
- (c) operating the machine to receive from the user via at least one user input to the machine authorization to have user identity data serve as an electronic signature of the user;
- (d) subsequent to (c), operating the machine to link the user identity data obtained in (a) to a document to which a signature of the user has legal significance, wherein the user identity data is linked so as to serve as the electronic signature of the user for the document.

38. The method according to claim 37 wherein the document comprises a financial check, and further comprising:

- (e) operating the machine to accept a check from the user;

wherein (d) includes correlating the user identity data with the check.

39. The method according to claim 38, and further comprising:

operating the machine to produce check image data corresponding to a visual image of the check.

(ix)

EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

(None)